

REMARKS

i. Status of the claims

Claims 2-9, 28-32, and 34 are pending. Claims 15-27 and 33 were canceled previously and claim 1 is canceled above, without prejudice or disclaimer. Claims 10-14 and 28-32 are withdrawn. Claims 4 and 6 are amended to delete dependency from claim 1, now canceled. Applicants explain the status of the claims in subsection iv, *infra*.

ii. Claim 1 is canceled, mooted the rejection under Section 102(b)

Applicants do not agree with the Examiner's rejection of claim 1 as allegedly anticipated under Section 102(b) by DE 1911328. Solely for the purposes of expediting prosecution and advancing this case to allowance, however, Applicants hereby cancel claim 1 without prejudice or disclaimer. Accordingly, the rejection is moot.

iii. Claims 2-9 and 34 are allowable

The Examiner indicates at page 3 of the Office Action that claims 2-9 and 34 "would be allowable if rewritten in independent form." Applicants point out that original claim 2 in independent format; hence, no revision is necessary. Further, Applicants have revised claim 6 to delete dependency from canceled claim 1. Accordingly, claims 2-9 and 34 are in condition for allowance.

iv. Review of claims status and during international and national stages

The present national-stage case was filed with original claims 1-36. Original claims 4, 12, and 16 of the *published* PCT claim set were deleted, however, and the published PCT claims thus were renumbered as claims 1-33.

The Office's restriction requirement of October 1, 2004, however, was made on the original claim set instead of the published PCT version of the claims, which accompanied the IPER during International prosecution. Applicants pointed out the Office's inadvertent

oversight in their paper filed December 1, 2004, but they also made an election, as required, of Group I (then, claims 1-4, 7-10, and 36).

Informed of the mistake, the Office kindly revised the restriction requirement in the present action dated January 13, 2005, along the following lines: (A) Group I, claims 1-9 and 33, drawn to a macromonomer having an oxetane as the terminated group; and (B) Group II, claims 10-32, drawn to polymer and its use.

By virtue of Applicants' prior election, the Office examined revised Group I. The Office did not take into consideration, however, Applicants' preliminary amendment of March 23, 2001, where they deleted renumbered claims 15-27 and 33, and added new claim 34. For the record, therefore, Applicants consider the correct status of the claims as follows:

Claims 2-9, 28-32, and 34 are pending. Claim 1 is canceled herein without prejudice or disclaimer. Claims 4, 5, 6, 7, 8, and 9 correspond to as-filed claims 5, 6, 7, 8, 9, and 10, respectively.

Claims 10-14 and 28-32 are withdrawn. Withdrawn claim 10 corresponds to as-filed claim 11. Withdrawn claims 11, 12, and 13 correspond to as-filed claims 13, 14, and 15. Withdrawn claim 14 corresponds to as-filed claim 17. Withdrawn claims 28-32 correspond to as-filed claims 32, 33, 34, and 35, respectively.

Claims 15-27 and 33 were deleted in the preliminary amendment of March 23, 2001.

Claim 34 was added in the preliminary amendment of March 23, 2001.

iv. Applicants petition the Director to review the restriction requirement

Applicants respectfully request reconsideration of the Examiner's basis for restricting the claims into Group I ("claims 1-9 and 33") and Group II ("claims 10-32"). Accordingly, Applicants file herewith a petition to the Director to review the restriction requirement in compliance with 37 CFR § 1.144 and 37 CFR § 1.181.

Based on Applicants' assessment of the claims, as related in the preceding subsection, claims 10, 11, 12, 13, 14, 28, 29, 30, 31, and 32 are withdrawn. Applicants request that these claims be rejoined to the examined claim set, claimd 2-9 and 34.

Claim 10 is a polymer that is "formed by the polymerization of" the novel macromonomer of claim 2. Claims 11-14 and 28-32 are all drawn to embodiments of this polymer. Accordingly, Applicants submit that there does exist a unitary connection between the presently claimed macromonomer and polymer.

The oxetane groups of the claimed macromonomer represent the polymerizable entity of the molecule and are responsible for forming the polymer from the macromonomer. It is the remaining terminal hydroxy groups of the mono-oxetane monomer units which are present in both monomer and polymer and which form the moieties in the polymer intended to be used as attachment points on the polymer for, for example, solid-phase synthesis. Hence, the polymer of present claim 10 is "formed by the polymerization" of the macromonomer of present claim 2. The polymer of claim 10 cannot be made otherwise.

Accordingly, Applicants maintain that there does exist a common unitary connection between the macromonomer and the polymer and request that the polymer of claims 10-14 and 28-32 be rejoined with the macromonomer of claim 2.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. Also, the Examiner is invited to contact the undersigned if he feels that a telephone interview would advance prosecution.

Respectfully submitted,

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